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In re Application of	:
YIP et al.	:
Application No.: 09/403,608	:
PCT No.: PCT/AU98/00868	: DECISION ON PETITION
Int. Filing Date: 18 October 1998	:
Priority Date: 21 October 1997	: UNDER 37 CFR 1.48(a)
Attorney Docket No.: 025265-155	:
For: COATED SUNGLASS LENS	:

This is in response to applicants' "PETITION TO CORRECT INVENTORSHIP PURSUANT TO 37 CFR 1.48(a)(1)" filed 27 April 2000. The required fee of \$130 under 37 CFR 1.17(i) has been submitted.

**BACKGROUND**

On 18 October 1998, applicants filed international application No. PCT/AU98/00868 which claimed a priority date of 21 October 1997. The international application named Brandon Yip, Colin James Hall, Frank Samson, and Brian Douglas Adams as inventors. A copy of international application was communicated to the United States Patent and Trademark Office from the International Bureau on 29 April 1999. A Demand for international preliminary examination was filed on 23 March 1999, prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 21 April 2000.

On 25 October 1999, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage accompanied by, *inter alia*, the requisite basic national fee, a copy of the international application, and a first preliminary amendment.

On 14 December 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not executed in accordance with 37 CFR 1.66 or 1.68.

On 14 February 2000, applicant filed "Transmittal Letter for Missing Parts of Application" accompanied by, inter alia: a petition for a one-month extension of time; oath and declaration surcharge under 37 CFR 1.492(e); and a declaration executed by Brandon Yip, Colin James Hall, Frank Samson, Brian Douglas Adams, and Randy Lee Gove.

On 28 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was defective because the fifth inventor (Randy Lee Gove) was not listed on the published international application.

On 27 April 2000, applicants filed a "Petition to Correct Inventorship Pursuant to 37 CFR 1.48(a)(1)," which was accompanied by a petition for a one-month extension of time and a declaration of Randy Lee Gove.

### **DISCUSSION**

In the instant case, the international application named Brandon Yip, Colin James Hall, Frank Samson, and Brian Douglas Adams as inventors. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a petition under 37 CFR 1.48(a) is required.

A petition under 37 CFR 1.48(a) to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied items (1), (2) and (3). In order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship in compliance

with 37 CFR 3.73(b), if the instant application has been assigned, or, in the alternative, a statement that the application has not been assigned.

**CONCLUSION**

For the reasons discussed above, applicants' petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)." No additional petition fee is required.

A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b), if the instant application has been assigned, or, in the alternative, a statement that the application has not been assigned.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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